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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/020,728      | 10/29/2001  | Seth P. Becker       | BEC-0041            | 9760             |

7590 04/20/2004

CANTOR COLBURN LLP  
55 Griffin Road South  
Bloomfield, CT 06002

| EXAMINER |
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KALINOWSKI, ALEXANDER G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3626

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## **DETAILED ACTION**

### ***Requirement for Information Under 37 C.F.R. § 1.105***

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
  
2. The information is required to identify products and/or services embodying the disclosed subject matter of a method for identifying uninsured motorists. The Examiner upon conducting a search for prior art, discovered a web site for Diamond I.D. (a copy of the information is attached to this request). The web site discloses a product called Diamond I.D that is a patented diamond identification, tracking and recovery system. Furthermore, the web site indicates that because of the Diamond I.D. registry, consumers have the ability to insure themselves against loss for jewelry at least from 4/1/2001 (publication date of the web page). In response to this requirement please provide any known publications, brochures, manuals and press releases that describe the Diamond I.D. product or service that is described by the Diamond I.D. web site and

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specifically what product or service was marketed or developed that was the subject of the web site disclosure.

3. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

4. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

5. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain

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an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

6. This requirement is subject to the provisions of 37 C.F.R. §§ 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

#### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

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If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 872-9306 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

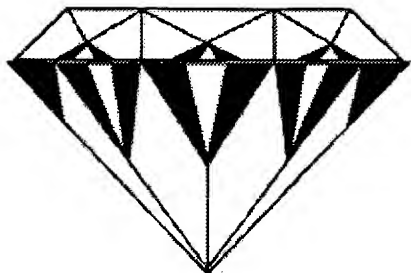
A handwritten signature in black ink, appearing to read "Alexander Kalinowski", with a stylized flourish at the end.

Alexander Kalinowski

Patent Examiner

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April 5, 2004



**The Diamond I.D. Web site is being upgraded.**

We will be online shortly.

**"Identify & Protect Your Diamonds Forever"**

**CONTACT: Jack Gredinger, President**

**DIAMOND I.D.™**

**53 Gisella Rd, Trumbull, Ct. 06611**

**toll free: 1-888-343-5599**

**tel#: 203-261-3085**

**fax#: 877-343-6666**

**email: [jack@diamondid.com](mailto:jack@diamondid.com)**

The DIAMOND I.D.™ U.S. patented (5,983,238) diamond and gemstone identification, tracking and recovery system provides a database that stores and retrieves information permanently cross-referencing diamonds and gemstones inscribed or marked (by any method) with its consumer owner.

Furthermore, because of the DIAMOND I.D.™ registry, consumers have the availability of one to two years of replacement insurance protection against theft, loss, or mysterious disappearance for the jewelry enrolled in the DIAMOND I.D. PROTECTION PLAN™ program.

**DIAMOND I.D.™ PROVIDES ADDED VALUE**

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## Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.